REMARKS/ARGUMENTS

Claims 1-32 are pending in the present application. In the Office Action mailed April 27, 2005, the Examiner rejected claims 1-32 under either 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a). Claim 11 was also objected to as containing an informality.

As a result of this paper, claims 1, 11, 12, 25, and 29 have been amended. In light of these changes and the following remarks, reconsideration and allowance of the present claims is respectfully requested.

I. Objection to Claim 11

In the Office Action, the Examiner objected to claim 11 as containing an informality. More particularly, the Examiner objected to claim 11 as having incorrect claim dependency. The amendment to claim 11 in the present paper corrects this issue. Accordingly, withdrawal of this claim objection is respectfully requested.

II. Rejection of Claims 1-5, 8-9, 12-16, and 19-20 Under 35 U.S.C. § 102(b)

In the Office Action, the Examiner rejected claims 1-5, 8-9, 12-16, and 19-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,410,453 issued to Ruskouski (hereinafter "Ruskouski"). These rejections are respectfully traversed.

As explained by the MPEP, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (*citing Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Id.* (*citing Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." *In re Paulsen*, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Independent claims 1 and 12 have been amended to recite that the "the lighting apparatus is coupled to a wall switch and wherein the illumination of the light-emitting diodes is controllable based upon the position of the wall switch." Support for this limitation is found in paragraphs 39-47, and more particularly in paragraphs 44-45, of Applicants' specification.

Applicants submit that this limitation is not disclosed by Ruskouski. Specifically, Ruskouski teaches a lighting system that is used to illuminate an "EXIT" sign. "EXIT" signs are constantly-illuminated signs that are commonly found in theaters, office buildings, restaurants, commercial buildings, etc. as a means of indicating to building occupants how they may safely exit the building in the event of an emergency, in the event that the building loses power, etc. *See* Ruskouski, Col. 1, lines 8-16. To the extent that the illuminated "EXIT" signs taught by Ruskouski may be interpreted as comprising the "lighting apparatus" of claim 1 and 12, Ruskouski does not teach that that the illumination of light-emitting diodes within Ruskouski's "EXIT" signs "is controllable based upon the position of the wall switch." Rather, Ruskouski (like other types of "EXIT" signs known in the art) teaches a system in which the "EXIT" signs will be constantly illuminated and will not be controlled by a user turning a wall switch on or off.

Thus, because Ruskouski fails to disclose the above-recited claim elements outlined by independent claims 1 and 12, this reference does not operate to anticipate these claims under 35 U.S.C. § 102(b). Withdrawal of this rejection is respectfully requested.

With respect to dependent claims 2-5 and 8-9, these claims depend either directly or indirectly from independent claim 1. Likewise, claims 13-16 and 19-20 depend either directly or indirectly from independent claim 12. Accordingly, Applicants respectfully request that the rejection of dependent claims 2-5, 8-9, 13-16 and 19-20 be withdrawn for at least the same reasons as those presented above in connection with claims 1 and 12.

III. Rejection of Claims 6-7, 17-18, 28, and 32 Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 6-7, 17-18, 28, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Ruskouski in view of U.S. Patent No. 4,255,746 issued to Johnson *et al.* (hereinafter "Johnson"). This rejection is respectfully traversed.

The M.P.E.P. states that

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.
>
> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references in that these claims contain limitations that are not taught or suggested by the prior art.

With respect to claims 6, 7, 17, 18, and 32, these dependent claims all include the limitation that the "lighting apparatus is coupled to a wall switch and wherein the illumination of the light-emitting diodes is controllable based upon the position of the wall switch." As explained above in greater detail, this limitation is not taught or suggested by Ruskouski. Likewise, Applicants can find no teaching or disclosure in Johnson (nor has the Examiner cited

to any such teaching) that would make up for the deficiencies of Ruskouski. Accordingly, because all of the limitations found in claims 6, 7, 17, 18, and 32 are not taught by either Ruskouski and Johnson, and as such, this combination of references does not operate to render claims 6, 7, 17, 18, and 32 *prima facie* obvious under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

Further, dependent claim 28 depends from claim 25 and thus recites the limitation that "the light fixture is coupled to a wall switch and wherein the illumination of the light-emitting diodes is controllable based upon the position of the wall switch." As with the limitations previously discussed, this limitation is likewise not taught or suggested by Ruskouski or Johnson. Accordingly, because Ruskouski and Johnson fail to teach or suggest this limitation, this claim may not be rejected as being obvious in light of these references. Withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 10-11 and 21-22 Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 10-11 and 21-22 under 35 U.S.C. § 103(a) as being unpatentable over Ruskouski in view of U.S. Patent Reissue No. 36,696 issued to Blackman (hereinafter "Blackman"). This rejection is respectfully traversed.

As explained above, a claim cannot properly be rejected under 35 U.S.C. § 103(a) unless all of the claim limitations are taught or suggested by the cited references. *See e.g.,* M.P.E.P. § 2143.03. Applicants respectfully submit that all of the limitations of claims 10, 11, 21, 22 are not found in the prior art references. Specifically, dependent claims 10, 11, 21, and 22 all include the limitation that the "the lighting apparatus is coupled to a wall switch and wherein the illumination of the light-emitting diodes is controllable based upon the position of the wall switch." As explained above in greater detail, this limitation is not taught or suggested by Ruskouski. Likewise, Applicants can find no teaching or disclosure in Blackman (nor has the Examiner cited to any such teaching) that would make up for the deficiencies of Ruskouski.

Accordingly, Applicants submit that all of the limitations found in claims 10, 11, 21, and 22 are not taught by Ruskouski and Blackman, and as such, this combination of references does not render these claims *prima facie* obvious under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 23 Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Ruskouski in view of U.S. Patent No. 4,216,524 issued to Leveraus (hereinafter "Leveraus"). This rejection is respectfully traversed.

As explained above, a claim cannot properly be rejected under 35 U.S.C. § 103(a) unless all of the claim limitations are taught or suggested by the cited references. *See* M.P.E.P. § 2143.03. Applicants respectfully submit that all of the limitations of claim 23 are not found in the prior art references. Specifically, claim 23 depends from claim 12 and thus includes the limitation that the "lighting apparatus is coupled to a wall switch and wherein the illumination of the light-emitting diodes is controllable based upon the position of the wall switch." As explained above in greater detail, this limitation is not taught or suggested by Ruskouski. Likewise, Applicants can find no teaching or disclosure in Leveraus (nor has the Examiner cited to any such teaching) that would make up for the deficiencies of Ruskouski. Accordingly, because the combined teachings of Ruskouski and Leveraus do not teach or suggest all of the limitations found in claim 23, this claim cannot properly be rejected under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

VI. Rejection of Claim 24 Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Ruskouski in view of U.S. Patent No. 4,204,272 issued to Kim (hereinafter "Kim"). This rejection is respectfully traversed.

As explained above, a claim cannot properly be rejected under 35 U.S.C. § 103(a) unless all of the claim limitations are taught or suggested by the cited references. *See* M.P.E.P. § 2143.03. Applicants respectfully submit that all of the limitations of claim 24 are not found in the prior art references. Specifically, claim 24 depends from claim 12 and thus includes the limitation that the "lighting apparatus is coupled to a wall switch and wherein the illumination of the light-emitting diodes is controllable based upon the position of the wall switch." As explained above in greater detail, this limitation is not taught or suggested by Ruskouski. Likewise, Applicants can find no teaching or disclosure in Kim (nor has the Examiner cited to any such teaching) that would make up for the deficiencies of Ruskouski. Accordingly, because the combined teachings of Ruskouski and Kim do not teach or suggest all of the limitations found in claim 24, this claim cannot properly be rejected under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

VII. Rejection of Claims 25-27 and 29-31 Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 25-27 under 35 U.S.C. § 103(a) as being unpatentable over Ruskouski. This rejection is respectfully traversed.

As explained above, a claim cannot properly be rejected under 35 U.S.C. § 103(a) unless all of the claim limitations are taught or suggested by the cited references. *See* M.P.E.P. § 2143.03. With respect to claims 29-31, these claims all recite the limitation that the "lighting apparatus is coupled to a wall switch and wherein the illumination of the light-emitting diodes is controllable based upon the position of the wall switch." As explained above, this limitation is not taught or suggested by Ruskouski, and thus, Ruskouski may not be used to reject these claims under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

Claims 25-27 also have limitations that are not taught or suggested by Ruskouski. Specifically, claims 25-27 recite the limitation that the "light fixture is coupled to a wall switch" and that the "illumination of the light-emitting diodes is controllable based upon the position of

the wall switch." As with the limitations previously discussed, this limitation is not taught or suggested by Ruskouski. Specifically, there is no teaching in Ruskouski that the light-emitting diodes will illuminate when the wall switch is turned to an open position. Accordingly, because this limitation is not taught or suggested by Ruskouski, this reference cannot render claims 25-27 *prima facie* obvious under 35 U.S.C. § 103(a). Withdrawal of this rejection is respectfully requested.

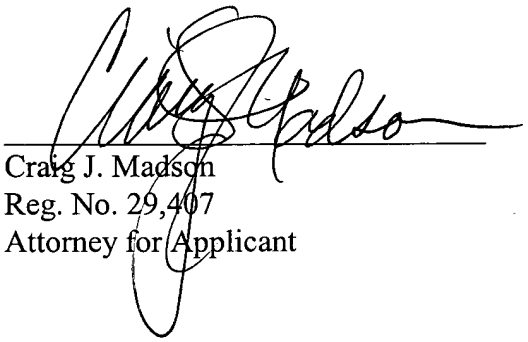
VIII. Information Disclosure Statement

The Examiner objected to the "Non-Patent Publications" section of the Information Disclosure Statement ("IDS") that the Applicants filed on March 25, 2004. Applicants note that they have addressed the concerns raised by the Examiner with respect to this IDS and have resubmitted an IDS with the present submission. The appropriate fee as required by 37 C.F.R. 1.97(e) also accompanies this submission.

IX. Conclusion

Given the foregoing amendments and remarks, Applicants respectfully assert that all pending claims are patentably distinct from the cited references. As such, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned. Likewise, with respect to any of the fees/charges associated with the present application, the Commissioner is instructed to credit any overpayments or charge any deficiencies to Deposit Account 13-0763.

Respectfully submitted,



Craig J. Madson
Reg. No. 29,407
Attorney for Applicant

Date: October 6, 2005

MADSON & METCALF
Gateway Tower West
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: 801/537-1700

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